

## REMARKS

Applicant has studied the Office Action dated March 29, 2006, and has made amendments to the claims. Claims 1-18 are pending. Claims 1, 13 and 18 are independent claims. Claims 5, 6, 8, 10, 11, 13 and 18 have been amended. No new matter has been entered. It is submitted that the application, as amended, is in condition for allowance. Reconsideration and reexamination are respectfully requested.

### Amendments to Drawings

FIG. 5 has been amended in response to objections by the Examiner. No new matter has been added as the amendment has support in the application as originally filed.

### Objection to Drawings

The Examiner objected to the drawings. Specifically, the Examiner asserted that the word "SELSCTION" in step ST11 should be "SELECTION."

With this paper, amended Figure 5 has been submitted with the change suggested by the Examiner. It is respectfully requested that the objection be withdrawn.

### Amendments Claims

Amendments have been made to claims 6, 8, 10, 11 and 18 in order to address objections by the Examiner, correct typographical errors and more clearly disclose the invention. It is respectfully submitted that the amendments are not related to patentability.

### Claim Objections

The Examiner objected to claims 11, 13 and 18 due to informalities. Specifically, the Examiner asserted the following:

The phrase "input/out" at line 2 of claim 11 should be "input/output".

The semicolon after the word "comprising" at line 2 of claim 13 should be a colon.

The phrase "in formation" at line 8 of claim 18 should be the word "information".

There is insufficient antecedent basis for the phrase "the action of the toy" at line 10 of claim 18.

With this paper, claims 11, 13 and 18 have been amended as suggested by the Examiner. Furthermore, the phrase "the action" at line 10 of claim 13 has been amended to "an action" to overcome the asserted antecedent basis issue.

### § 102 Rejections

Claims 1-4, 6, 7 and 11-17 were rejected under 35 U.S.C. § 102(e) as being anticipated by Ng (U.S. Patent No. 5,971,855). Applicant respectfully disagrees with the Examiner's interpretation of Ng and respectfully traverses the rejection.

It is respectfully noted that a proper rejection for anticipation under § 102 requires complete identity of invention. The claimed invention, including each element thereof as recited in the claims, must be disclosed or embodied, either expressly or inherently, in a single reference. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991); Standard Havens Prods., Inc. v. Gencor Indus., Inc., 953 F.2d 1360, 1369, 21 U.S.P.Q.2d 1321, 1328 (Fed. Cir. 1991).

Is respectfully noted that the present invention is directed to a toy learning apparatus and a method for using a cyber community in which a toy grown offline and a cyber character grown in a cyber community can exchange information with each other. That is, the cyber character does not grow by simply receiving a user's learning experience, but rather grows by sharing an experience of the cyber character itself and the user's learning experience.

On the other hand, it is respectfully noted that the Ng discloses only performing a preprogrammed game and to modify characteristics of the preprogrammed game such that growth and development of a cyber character is simulated according to preset game functions and commands input by a user. That is, Ng does not disclose any exchange of information between a toy grown offline and a cyber character grown in a cyber community. In order to more clearly illustrate the patentable difference between the present invention and Ng, several limitations of independent claims 1 and 13 will be addressed separately.

There is insufficient antecedent basis for the phrase "the action of the toy" at line 10 of claim 18.

With this paper, claims 11, 13 and 18 have been amended as suggested by the Examiner. Furthermore, the phrase "the action" at line 10 of claim 13 has been amended to "an action" to overcome the asserted antecedent basis issue.

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On the other hand, it is respectfully noted that the Ng discloses only performing a preprogrammed game and to modify characteristics of the preprogrammed game such that growth and development of a cyber character is simulated according to preset game functions and commands input by a user. That is, Ng does not disclose any exchange of information between a toy grown offline and a cyber character grown in a cyber community. In order to more clearly illustrate the patentable difference between the present invention and Ng, several limitations of independent claims 1 and 13 will be addressed separately.

**Claim 1 / A toy learning apparatus using a cyber community:**

It is respectfully noted that the Examiner asserts the "abstract" of Ng as disclosing this limitation, specifically citing the disclosure of "other game users connected to the website." However, it is further respectfully noted that Ng is directed to "communicating between handheld electronic game apparatus and other electronic systems" and specifically to a method where "a controller or processor receives, processes and controls ... a display" in order to "download upgrades to the preprogrammed game." Col. 1, ll. 7-9 and col. 2, ll. 28-30 and 41-44. It is respectfully submitted that the Examiner has not identified any toy that is disclosed by Ng as learning. It is further respectfully submitted that the connection of "other game users" to "the website" and "download upgrades to the preprogrammed game" disclosed in Ng does not enable any toy to learn, but rather facilitates "interactive play" between users and the modification of a computer game played in cyberspace.

**Claim 1 / a toy that grows by receiving one of a cyber character's experience and a user's learning experience:**

It is respectfully noted that the Examiner asserts "col. 4, lines 10-19" of Ng as disclosing this limitation, specifically citing the disclosure of "a hand-held electronic game apparatus that contains a virtual pet." However, it is also respectfully noted that the Examiner appears to assert the "virtual pet" disclosed in Ng as the cyber character with respect to the cyber character which grows by learning online recited in claim 1 when he asserts "col. 2, lines 47-56" of Ng as disclosing that limitation. It is respectfully submitted that the toy and the cyber character recited in the claims of the present invention are not the same, given that the toy exists offline and the cyber character exists online. It is further respectfully submitted that the distinction between the toy and the cyber character recited in the claims of the present invention is clearly indicated in

the specification as originally filed at pg. 1, ll. 8-11, pg. 2, ll. 6-11, pg. 4, ll. 2-6, pg. 5, ll. 7-10 and 16-20 and pg. 6, ll. 6-10. Therefore, it is further respectfully submitted that the "virtual pet" disclosed in Ng cannot be analogous to **both** the toy and the cyber character recited in the claims of the present invention.

**Claim 13 / A learning method for a toy using a cyber community:**

It is respectfully noted that the Examiner asserts the "abstract" of Ng as disclosing this limitation. Therefore, it is respectfully submitted that the previous comments with regard to the preamble of claim 1 are applicable.

**Claim 13 / having the toy obtain first experience information by one of controlling a certain part of the toy, controlling a remote controller and using information input means such as a microphone:**

It is respectfully noted that the Examiner asserts "col. 5, lines 13 –16" and "col. 5, lines 11-13" of Ng as disclosing this limitation, specifically citing the disclosure of "keyboard commands." However, it is further respectfully noted that the cited disclosure is directed to "modify game play" and to controlling the "virtual character." Therefore, it is respectfully submitted that the disclosure fails to read on the recited toy obtains first experience information since the only arguably disclosed "obtains" would be by the computer programmed "game" or by the "virtual character" in a "virtual community."

**Claim 13 / Storing the first experience information in a memory:**

It is respectfully noted that the Examiner asserts "col. 4, lines 40-45" of Ng as disclosing this limitation. However, it is further respectfully noted that the cited disclosure is the "processor accesses the preprogrammed game from the first memory and [controls] the display" and that "temporary data, such as scores, condition of the [virtual] Pet are stored in second memory." It is respectfully submitted that the disclosure is directed to the "preprogrammed game" and the "virtual character" or "Pet" and fails to read on the first experience information that is obtained by the toy, given that the toy exists offline.

**Claim 13 / having the toy learn by transmitting, from the network server to the toy, second experience information according to the activity of the cyber character in the cyber community:**

It is respectfully noted that the Examiner asserts "col. 4, lines 3-7" of Ng as disclosing this limitation, specifically citing the disclosure of "Website performing interaction/fighting between characters." However, it is further respectfully noted that the cited disclosure is the "Website can send messages or greeting screens to the [virtual] character," can "simulate another [virtual] character," can "connect two users and enable their [virtual] characters to interact" and can "make the user's character perform." It is respectfully submitted that the cited disclosure is related to controlling "virtual characters" according to their "users" and any transmitting of information is between "cyber characters" in a "virtual community" or between "users" and "cyber characters" and, therefore, fails to read on the recited transmitting, from the network server to the toy, second experience information according to the activity of the cyber character.

**Claim 13 / upgrading an operating/application program according to the extent of learning of the toy according to the second experience information:**

It is respectfully noted that the Examiner asserts "col. 4, line 66 through col. 8, line 21" of Ng as disclosing this limitation, specifically citing the disclosure of "modifying character stats based on the result of a fight." However, it is further respectfully noted that the cited disclosure is related to "a preprogrammed game in which the user cares for a character which can interact with other similar characters in an electronic system." Col. 5, ll, 41-43. Moreover, it is respectfully noted that the "preprogrammed game" is disclosed as one in which a "user" uses "'LCD icons ... on the LCD display" such as "Left and Right keys" and "Enter" in order to "train" a "[virtual] character" and cause his or her "[virtual] character" to engage in "Combat" with a "[virtual] character" of another user. It is respectfully submitted that the cited disclosure is related to a "user" controlling a "virtual character" and interaction between "virtual characters" in a "virtual community" and, therefore, fails to read on the recited upgrading an operating/application program according learning of the toy according to the second

experience information where the second experience information is according to the activity of the cyber character.

It is respectfully asserted that the Examiner has failed to show that Ng provides the required "complete identity of invention" and, therefore, that independent claims 1 and 13 are allowable over the cited reference. It is further respectfully asserted that claims 2-4, 6, 7, 9, 11 and 12, which depend from claim 1 and claims 14-17, which depend from claim 13, also are allowable over the cited reference.

Claim 18 was rejected under 35 U.S.C. § 102(e) as being anticipated by Matsuda, et al. ("Matsuda" U.S. Patent No. 6,405,249). Applicant respectfully disagrees with the Examiner's interpretation of Matsuda and respectfully traverses the rejection.

It is respectfully submitted that the present invention reflects offline experience information of a toy on a cyber character according to a selected user and reflects experience of the cyber character in a cyber community on the toy. In other words, the offline experience information of the toy according to a selected user is transferred to the cyber character in order to change activity in the cyber community and the online experience of the cyber character in the cyber community is transferred to the toy in order to change the offline actions of the toy.

On the other hand, it is respectfully submitted that Matsuda discloses to allow a user to change the growth parameters of a virtual character in order to change the activity of the virtual character in a virtual community. That is, the Matsuda invention only discloses a user to transferring information to a virtual character in a cyber community with no disclosure of altering the action of an offline toy according to the actions of the virtual character in the virtual community. In order to more clearly illustrate the patentable difference between the present invention and Matsuda, several limitations of independent claim 18 will be addressed separately.

**Claim 18 / reflecting the experience information of the toy on a cyber character in a cyber community according to the selected user and changing the activity of the cyber community according to the experience information of the toy and the selected user:**

It is respectfully noted that the Examiner asserted "col. 24, lines 45-53" of Matsuda as disclosing "reflecting the experience information of the toy on a cyber character in a cyber community according to the selected user." However, it is further respectfully noted that the cited disclosure is "when the call button A is clicked (the action panel is operated) on the own client PC [by a user] ... growth parameter update processing is performed" in order to alter "the appetite index, the health index, and the mood index [of the user's virtual reality character]." It is respectfully submitted that the cited disclosure is reflecting the actions of a "user" on a cyber character as opposed to reflecting the experience information of a toy on a cyber character.

It is respectfully noted that the Examiner asserted "col. 23, lines 40-49 and 53-57" of Matsuda as disclosing "changing the activity of the cyber community according to the experience information of the toy and the selected user." However, it is further respectfully noted that the cited disclosure is "an object AO controls the virtual reality objects placed in a virtual reality space" and "an area AO sets a special capability to a predetermined area in a shared virtual reality space ... to make virtual reality life objects compete with each other." It is respectfully submitted that, although the disclosure arguably is related to controlling a "virtual reality space" according to a "selected user," there is no disclosure of changing the activity of the "virtual reality space" according to any experience information from a toy.

**Claim 18 / reflecting the experience of the cyber character in the online cyber community on a current status of the toy by changing the action of the toy according to the experience of the cyber character:**

It is respectfully noted that the Examiner asserted "col. 25, lines 1-13" of Matsuda as disclosing this limitation. However, it is further respectfully noted that the cited disclosure is "controlling the autonomous behavior from the virtual reality pet growth based on growth parameters ... chang[ing] the field values ... for representing the virtual reality pet" and "perform[ing] rendering on the **virtual reality pet on which the changed field values are reflected** ... and display[ing] the rendered virtual reality pet." (emphasis added). It is respectfully submitted that the cited disclosure is changing the status of a cyber character according to the action of a "user" and reflecting the



changed status on the cyber character in order to change the action of the cyber character as opposed to reflecting actions of a cyber character on the status of a toy by changing the action of the toy according to the actions of the cyber character.

It is respectfully asserted that the Examiner has failed to show that Matsuda provides the required "complete identity of invention." Therefore, it is further respectfully asserted that independent claim 18 is allowable over the cited reference.

### § 103 Rejections

Claims 8 and 10 were rejected under 35 U.S.C. § 103(a) as unpatentable over Ng in view of Bushmitch et al. ("Bushmitch" U.S. Pat. No. 6,494,762). This rejection is respectfully traversed.

It is respectfully noted that the Federal Circuit has provided that an Examiner must establish a case of prima facie obviousness. Otherwise the rejection is incorrect and must be overturned. As the court recently stated in In re Rijkaert, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993):

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. 'A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.' If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned." (citations omitted.)

It is respectfully submitted that Bushmitch fails to cure the previously identified deficiencies of Ng with respect to independent claim 1. It is further respectfully submitted that Bushmitch, which is directed to automatically downloading information from an electronic subscription service to a portable computing device, further supports the difference between the offline toy and online cyber character of the present invention. The Examiner's attention is directed to the "programmable doll 114" and "robot turtle 220" as examples of offline toys that interact with a cyber community through a "subscription service" with the Bushmitch disclosure directed only to transfer of information from the cyber community represented by the "subscription service" to the

offline toy represented by the programmable doll 114" and "robot turtle 220." See Bushmitch col. 3, line 20 to col. 5, line 4.

Therefore, it is respectfully asserted that claim 1 is allowable over the cited combination of references. It is further respectfully asserted that claims 8 and 10, which depend from claim 1, also are allowable over the cited combination of references.

Claim 5 was rejected under 35 U.S.C. § 103(a) as unpatentable over Ng in view of Creatures (computer game review published in <http://www.Avault.com/reviewstemp.asp?game=creature> on July 16, 1997) and further in view of Bushmitch. This rejection is respectfully traversed.

It is respectfully submitted that Creatures fails to cure the previously identified deficiencies of Ng and Bushmitch with respect to independent claim 1. Therefore, it is respectfully asserted that claim 1 is allowable over the cited combination of references. It is further respectfully asserted that claim 5, which depends from claim 1, also is allowable over the cited combination of references.

### CONCLUSION

In light of the above remarks, Applicant submits that claims 1-18 of the present application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are requested.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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Encl: Substitute FIG. 5

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